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IGB 1532-US 41IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: KING et al.

Serial No.: 09/713,450

Filed: November 15, 2000

Group Art Unit: 1774

Examiner: B. Shewareged

Date: November 15, 2004

For: PRINTING PROCESS

Commissioner for Patents
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TC 1700RESPONSE TO RESRICTION REQUIREMENT
AND AMENDMENT11/19/2004 MBERHE 00000003 501541 09713450
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Sir/Madame:

Applicants herein petition for an extension of time for one (1) month, up to and including November 15, 2004. This response is timely filed with a one-month extension, since November 13th fell on a Saturday. Please charge \$110 to deposit account 50-1541 (a duplicate copy of this page is also enclosed).

This is responsive to the Office Action dated July 13, 2004 in the above-identified application.

The Examiner has required that an election of invention be made between the following invention Groups: the recording medium of Group I (Claims 1-12) and the printing method of Group II (Claims 13-24). In a telephone conversation with the Examiner the Applicants elected the invention of Group II (Claims 13-24) with traverse. This election is confirmed herein.

The Examiner asserts that the inventions of Group I and II are distinct because the claimed product can be used in a materially different process of using that product (MPEP § 806.05(h)). By way of Example, the Examiner asserts that the claimed recording medium could be used as a gift wrap.

Applicants respectfully disagree. In independent Claim 1 the product of the invention is defined as a recording medium for ink jet printing made of a substrate "coated with at least one ink receiving layer comprising a particulate polymer having a film forming temperatures between 60 to 140°C and a binder".

As defined in independent Claim 13, it is this recording medium which is used in the claimed printing methods. Moreover, the claimed printing methods require the printed image to be heated after printing to form a stable image-protecting coating. Thus, the invention product provides an ink jet recording medium and the invention process describes a printing method using this

medium. Applicant's are not certain how the claimed recording medium could be used as a gift wrap as the Examiner suggests, when in fact the product and process claims are related as described above. Applicants assert that the Examiner's example has no support since there is no evidence that the claimed recording medium could be used as gift wrap.

The Manual of Patent Examining Procedure provides that restriction between patentably distinct inventions is proper when (1) the inventions are independent or distinct as claimed, and (2) unrestricted examination would seriously burden the Examiner. See MPEP 803. Neither criterion is met in the present case. It is believed that the fields of search for the recording medium and printing method claims of the invention overlap and that Patent efficiencies will be furthered by unrestricted examination of the application.

For the foregoing reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine claims 1-24 together.

A M E N D M E N T

This Amendment is responsive to the office action dated July 13, 2004.

Please amend Claim 13 and withdraw Claims 1-12 as directed to a non-elected invention claim grouping: